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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,725	11/27/2001	Mitsuru Kurita	862.782 CI/DI	1399
5514	7590	11/10/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			BRINICH, STEPHEN M	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

2624

DATE MAILED: 11/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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09/993725

EXAMINER

ART UNIT	PAPER
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DATE MAILED:

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Commissioner for Patents

Office Action Summary

Application No.

09/993,725

Applicant(s)

KURITA ET AL.

Examiner

Stephen M Brinich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-16 and 21-28 is/are rejected.
- 7) ☒ Claim(s) 17-20 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 24.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16 & 23-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 16, lines 1-2, the term "the dot" lacks proper antecedent basis.

In claim 23, line 10, the term "the third image information" lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United

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States and was published under Article 21(2) of such treaty in the English language.

4. Claims 13-15 & 22-27, insofar as claims 21-28 are understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Colvill et al.

Re claims 13 & 23, Colvill et al discloses (column 13, line 48 - column 14, line 13; Figure 1) an image forming system in which an original image (from input device 2) is superimposed with a additional information conveyed by a second predetermined image (microlettering, which is difficult for the human eye to perceive because of its small size) and a print image is formed in accordance with the resulting combined image.

Re claims 14 & 25, Colvill et al further discloses (column 26, lines 64-67) the use of a superimposed image marking which indicates the position of additional information.

Re claims 15 & 27, Colvill et al further discloses (column 13, lines 52-54) the identification of the issuing bank (which inherently identifies the apparatus and/or operator, at least to the extent of indicating that they are among those associated with that bank) in the microlettering image.

Re claim 16, the microlettering process inherently modulates (alters the value of) pixels in the microlettering region.

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Re claim 22, Colvill et al further discloses (column 21, lines 62-65) a color conversion process.

Re claim 24, Colvill et al further discloses (Figure 1) the use of a computer (CPU 1) as an external controller for the scanning (input 2) and printing (printer 6) operations.

Re claim 26, the disclosed ink jet printer (6) inherently forms an image by depositing dots of ink upon a medium, in accordance with the operation of an "ink jet printer" as that term is understood by one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 21 & 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colvill et al.

Re claims 21 & 28, Colvill et al does not indicate the color of the microlettering image. The use of a color most unnoticeable to the human eye for the purpose of making the

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microlettering less noticeable (thus enhancing the advantage of using microlettering rather than standard lettering) would be an expedient obvious to one of ordinary skill in the art.

Allowable Subject Matter

7. Claims 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

Re claim 17 (and dependent claims 18-20), the art of record does not teach or suggest the recited relative dot positional relationship arrangement.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 703-305-4390. The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2600 Customer Service center at 703-306-0377.


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If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 703-308-7452.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 703-872-9306.

Hand-carried or courier-delivered correspondence pertaining to this application should be directed to

US Patent and Trademark Office
220 South 20th Street
Crystal Plaza Two, Lobby, Room 1B03
Arlington VA 22202


Stephen M Brinich
Examiner
Art Unit 2624

smb
October 28, 2004